REMARKS

Claims 11-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Reber, *et al.* (U.S. Patent No. 5,798,694) (hereafter "Reber"). As will be shown below, the Office Action fails to provide Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132, the Office Action does not establish a prima facie case of anticipation by Reber, Reber does not anticipate each and every element of the Applicants' claims in the present application, and the theory of inherency is not available as a basis for rejection of claims in the present case. Claims 11-20 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 11-20.

Claims 1-30 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Reber in view of Well Known Prior Art. As will be shown below, the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution, the Office Action cannot rely on Well Known Prior Art to support the obviousness rejection, the Office Action does not establish a prima facie case for obviousness, and neither Reber nor Well Known Prior Art, either alone or in combination, teaches or suggests a method, system, or computer program product for inventory control as claimed in the present application. Claims 1-30 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-30.

The Office Action takes the position that Applicants have decided not to be their own lexicographer. As explained below in more detail, Applicants have included in the specification a section for definitions, and explanations of many claim elements and limitations throughout the specification. Applicants therefore have decided to be their own lexicographer.

The Office Action takes the position that claims 11-30 are product or machine claims. As explained in more detail below, Applicants respectfully submit that claims 11-20 are

directed to a system patentable under 35 U.S.C. § 101 and claims 21-30 are directed to patentable articles of manufacture within the meaning of 35 U.S.C. § 101.

Claim Rejections – 35 U.S.C. § 102 Over Reber

Claims 11-20 stand rejected under 35 § U.S.C. § 102(e) as being anticipated by Reber. As discussed in detail below, Applicants respectfully submit that the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132. In addition, the Office Action does not establish a prima facie case of anticipation by Reber because the Office Action does not even mention many of the elements of the Applicants' claims. Moreover, examining the substance of Reber confirms that Reber does not anticipate each and every element of the Applicants' claims in the present application. Finally, the theory of inherency is not available as a basis for rejection of claims in the present case. For these reasons, the rejections should be withdrawn and the claims should be allowed.

The Office Action Fails To Provide The Applicants With Information Sufficient To Judge The Propriety Of Continuing Prosecution As Required By 35 U.S.C. § 132

The Office Action under numbered paragraph 4 sets forth the following omnibus rejection of most of the elements of claim 11 over Reber:

> Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694).
>
> Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range (e.g. if a refrigerated item has a temperature which is outside an acceptable range, notification is made).

The mere assertion that Reber anticipates claims 11-20 does not give the Applicants adequate notification of the reasons for the rejection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for the rejections, including "such information and references as may be useful in judging of the propriety of continuing the prosecution…" The second sentence of 37 C.F.R. § 1.104(c)(2) requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "…the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)…." MPEP § 707.07(d) warns against such omnibus rejections as made in the Office Action as, "…stereotyped and usually not informative and should therefore be avoided." In this Office Action, the assertion that Reber anticipates claims 11-20 of the present application is accompanied by no explanation whatsoever of where in Reber the information relied on by the Examiner may be found. Reber describes, among other things:

- food storage apparatus
- a container for containing a food item
- a first electrical component associated with the container
- a second electrical component associated with the cover
- the first electrical component communicating with the second electrical component
- communication between electrical components when the cover seals the opening of the container
- the cover that includes a first at least one electrical contact and the container includes a second at least one electrical contact to provide an electrical coupling between the first electrical component and the second electrical component when the cover seals the opening of the container
- one of the first electrical component and the second electrical component includes a sensor, and another of the first electrical component and the second electrical component includes an indicator

- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory, and another of the first electrical component and the second electrical component includes an indicator
- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory.
- container sized for carrying by an individual
- container has a capacity less than or equal to 10 liters
- determining a first time at which the food item is removed from the storage place
- determining a second time at which the food item is returned to the storage place
- determining time duration that the food item is outside of a storage place

Reber is a complex reference containing information regarding many technical subjects and other inventions. In this circumstance, it is important for the Office Action to provide some indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections. For these reasons alone, the rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

The Office Action Has Not Established Anticipation By Reber Because The Office Action Does Not Even Mention Many Of The Elements Of Applicants' Claims

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. § 102. Nevertheless, in an effort to move the case forward and without prejudice to Applicant's request that the rejections should be withdrawn, Applicants submit with respect that the Office Action

has not established anticipation by Reber because the Office Action does not even mention many of the elements of Applicants' claims.

As stated in *Verdegaal Bros. v. Union Oil Co. of California*, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The rejected claims 11-20 contain the following elements and limitations:

Elements and limitations of claim 11:

- providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:
    - an RFID identification tag code field,
    - a control value,
    - an acceptable control value range, and
    - an out of range action
- detecting changes in the inventory item attributes, wherein computer program instructions capable of detecting changes in inventory item attributes include computer program instructions capable of reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item
- recording detected changes in inventory item attributes
- comparing the control value and the acceptable control value range
- taking action in dependence upon the result of the comparing and the out of range action

Elements and limitations of claim 12:

- wherein the computer program instructions capable of detecting changes, computer program instructions capable of recording detected changes, computer program instructions capable of comparing the control value and the acceptable control value range, and computer program instructions capable of taking action are carried out through Java servlets in at least

one OSGi-compliant service bundle installed and operating in an OSGI-compliant service gateway

Elements and limitations of claim 13:

- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'
- wherein computer program instructions capable of detecting changes includes computer program instructions capable of reading the weight of the inventory item from a scale
- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of storing the weight of the inventory item in the control value

Elements and limitations of claim 14:

- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'
- wherein computer program instructions capable of detecting changes in the inventory attributes of the inventory item further comprises:
    - computer program instructions capable of reading from a clock the time when the inventory item is removed from a refrigerator,
    - computer program instructions capable of reading the temperature from a kitchen thermometer,
    - computer program instructions capable of reading from the clock the time when the inventory item is returned to the refrigerator, and
    - computer program instructions capable of calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature
- wherein computer program instructions capable of recording detected changes comprises means for storing the freshness coefficient in the control value

Elements and limitations of claim 15:

- wherein the inventory item attributes further comprise a control value unit field set to `utilization`

- wherein computer program instructions capable of detecting changes in the inventory attributes of the inventory item includes computer program instructions capable of detecting that the inventory item has been removed from and returned to an inventory storage location

- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized

Elements and limitations of claim 16:

- wherein the inventory item comprises a quantity of separate items

- wherein the inventory item attributes further comprise a control value unit field set to 'count'

- wherein computer program instructions capable of detecting changes in the inventory attributes includes computer program instructions capable of detecting that one of the separate items has been removed from inventory

- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of decrementing the control value, wherein the control value represents the quantity of separate items

Elements and limitations of claim 17:

- wherein the inventory item attributes further comprise:
  - a control value unit field set to 'days', and
  - an inventory date representing the date when the inventory item entered inventory

- wherein computer program instructions capable of detecting changes comprises:

- computer program instructions capable of reading from a clock the current date, and
- computer program instructions capable of calculating the age of the inventory item in dependence upon the current date and the inventory date

- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of storing the age of the inventory item in the control value

Elements and limitations of claim 18:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range

Elements and limitations of claim 19:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range

Elements and limitations of claim 20:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

As mentioned above, the Office Action under numbered paragraph 4, regarding Reber, states:

> Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694).

> Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range (e.g. if a refrigerated item has a temperature which is outside an acceptable range, notification is made).

In response, Applicants note that the Office Action only states that Reber discloses the following claim limitations:

- means for providing inventory item attributes
- wherein the inventory item attributes describe an inventory item
- an RFID identification tag
- RFID identification tag code field
- the RFID tag detects changes
- records changes
- compares control values with acceptable values
- takes action if those actions are outside a range

That is, the Office Action only appears to direct Reber to claim 11 of the present application. The Office Action, however, makes no mention whatsoever of any of the following limitations and elements as required by the Federal Circuit in *Verdegaal Bros.*:

Elements and limitations of claim 11 not mentioned in the Office Action:

- … comprising data elements in computer memory, …, the inventory item… has an… having an RFID identification tag code, and the inventory item attributes comprise:
    - a control value,
    - an acceptable control value range, and

- an out of range action

- … in the inventory item attributes, wherein computer program instructions capable of detecting changes in inventory item attributes include computer program instructions capable of reading, through an RFID reader, the RFID identification code from the … associated with the inventory item

- … detected … in inventory item attributes

- … and … control … range

Elements and limitations of claim 12 not mentioned in the Office Action:

- wherein the computer program instructions capable of detecting changes, computer program instructions capable of recording detected changes, computer program instructions capable of comparing the control value and the acceptable control value range, and computer program instructions capable of taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway

Elements and limitations of claim 13 not mentioned in the Office Action:

- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'

- wherein computer program instructions capable of detecting changes includes computer program instructions capable of reading the weight of the inventory item from a scale

- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of storing the weight of the inventory item in the control value

Elements and limitations of claim 14 not mentioned in the Office Action:

- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'

- wherein computer program instructions capable of detecting changes in the inventory attributes of the inventory item further comprises:

- computer program instructions capable of reading from a clock the time when the inventory item is removed from a refrigerator,
- computer program instructions capable of reading the temperature from a kitchen thermometer,
- computer program instructions capable of reading from the clock the time when the inventory item is returned to the refrigerator, and
- computer program instructions capable of calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature

* wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of storing the freshness coefficient in the control value

Elements and limitations of claim 15 not mentioned in the Office Action:

* wherein the inventory item attributes further comprise a control value unit field set to 'utilization'
* wherein computer program instructions capable of detecting changes in the inventory attributes of the inventory item includes computer program instructions capable of detecting that the inventory item has been removed from and returned to an inventory storage location
* wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized

Elements and limitations of claim 16 not mentioned in the Office Action:

* wherein the inventory item comprises a quantity of separate items
* wherein the inventory item attributes further comprise a control value unit field set to 'count'
* wherein computer program instructions capable of detecting changes in the inventory attributes includes computer program instructions capable of detecting that one of the separate items has been removed from inventory

- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of decrementing the control value, wherein the control value represents the quantity of separate items

Elements and limitations of claim 17 not mentioned in the Office Action:

- wherein the inventory item attributes further comprise:
  - a control value unit field set to 'days', and
  - an inventory date representing the date when the inventory item entered inventory
- wherein computer program instructions capable of detecting changes comprises:
  - computer program instructions capable of reading from a clock the current date, and
  - computer program instructions capable of calculating the age of the inventory item in dependence upon the current date and the inventory date
- wherein computer program instructions capable of recording detected changes comprises computer program instructions capable of storing the age of the inventory item in the control value

Elements and limitations of claim 18 not mentioned in the Office Action:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range

Elements and limitations of claim 19 not mentioned in the Office Action:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range

Elements and limitations of claim 20 not mentioned in the Office Action:

- wherein computer program instructions capable of taking action comprises computer program instructions capable of sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

Though the Office Action rejects claims 11-20 as anticipated by Reber, the Office Action only cites a few phrases from claim 11 of the present application to support the rejection under 35 U.S.C. § 102(e). The remaining elements and limitations of claim 11 are not even mentioned. In addition, the Office Action does not mention any of the additional elements claimed in dependent claims 12-20 as being anticipated by Reber. Because the Office Action does not mention all of the elements and limitations of claims 11-20, the rejections under 35 U.S.C. § 102(e) should be withdrawn, and claims 11-20 should be allowed.

Examination Of Reber Confirms That Reber Does Not Anticipate Each And Every Element As Set Forth In The Applicants' Claims

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §102. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

To anticipate claims 11-20 under 35 U.S.C. § 102(b), two basic requirements must be met. As stated in *Verdegaal Bros. v. Union Oil Co. of California*, the first requirement of anticipation is that Reber must disclose each and every element as set forth in Applicants' claims. *Verdegaal Bros.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The second requirement of anticipation from *In re Hoeksema* is that Reber must enable

Applicants' claims. *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). Reber does not meet either requirement and therefore does not anticipate Applicants' claims.

As mentioned above, the Office Action under numbered paragraph 4, regarding Reber, states:

> Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694).
>
> Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range (e.g. if a refrigerated item has a temperature which is outside an acceptable range, notification is made).

What Reber in fact discloses is a "Food Storage Apparatus And Methods And Systems For Monitoring A Food Item." Reber, *et al.* (U.S. Patent No. 5,798,694), Title Block (54). The principal purpose of Reber is described in column 10, lines 58-60, stating:

> Because the various embodiments of the present invention provide communication of signals between a cover and a container, they provide a significant improvement in that various functions provided by a food storage apparatus can be distributed therein. Additionally, the various embodiments of the present invention as herein-described monitor a condition of a food item to alert an individual of a discard condition of a food item requiring refrigeration.

In fact, the overall message of Reber is that of a food storage apparatus capable of indicating when a food item should be discarded. For further examples of Reber's disclosure and enablement of a food storage apparatus and a method of monitoring a food item, please consider the following excerpts:

- The system includes a food storage apparatus 22 for containing the food item 20 and a storage place 24 for storing the food storage apparatus 22. (column 2, lines 14-18).

- The food storage apparatus 22 includes a container 26 for containing the food item 20. (column 2, lines 19-20).

- Optionally, the food storage apparatus 22 includes a cover 28 to cover the opening of the container 26. (column 2, lines 25-26).

- The container 26 and the cover 28 can be suited for storing and dispensing perishable food items, dry food items, liquid food items, or any combination thereof. (column 2, lines 44-46).

- The food storage apparatus 22 includes an electronic tag 30 … to monitor at least one condition of the food item 20. (column 3, lines 23-28).

- The indicator 36 can provide an alert or a warning of the condition of the food item 20. (column 3, lines 64-65).

- As with the indicator 36, the indicator 40 can provide either an audible indication or a visual indication of a condition of the food item 20…. (column 4, lines 5-8).

- In a preferred embodiment, the indication is utilized to alert an individual of a condition in which a food item requiring refrigeration should be discarded. (column 4, lines 28-31).

Reber discloses and enables a food storage apparatus and a method of monitoring a food item having little or nothing to do with a system of inventory control as claimed in the present application. As further evidence of the lack of disclosure and enablement in Reber regarding a system of inventory control as claimed in the present application, please note that not one of the following terms or phrases from claims 11-20 of the present application occurs anywhere in Reber, not even once:

- inventory item attributes
- computer memory
- inventory item
- RFID identification tag
- RFID identification tag code field
- control value
- acceptable control value range

- out of range action
- detecting changes
- RFID reader
- recording
- comparing the control value
- taking action
- Java
- OSGI
- gateway
- pounds
- reading the weight
- weight
- scale
- clock
- thermometer
- freshness coefficient
- utilization
- inventory storage location
- quantity
- separate items
- count
- days
- date
- entered inventory
- calculating the age
- storing the age
- emailing
- order
- vendor
- reorder the inventory item
- advising the user

In these circumstances there is no sound basis for believing that Reber in any way discloses or enables elements of claims 11-20 in the present application. Reber discloses a food storage apparatus and method for monitoring a food item, while the present application claims a system of inventory control. Reber also never once mentions many of the words in Applicants' claims 11-20. The Office Action therefore does not establish anticipation under 35 U.S.C. § 102(e) under Reber. The rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

The Theory of Inherency Is Not Available As A Basis For Rejection Of Claims In The Present Case

The Office Action under numbered paragraph 4, regarding Reber, states:

> Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory items attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent)…

That is, the Office Action, by parenthetically inserting the term 'inherent' in a description of a claim element, apparently intends to invoke the theory of inherency as a basis for rejection of claim 11 in the present case. Except for this one, cryptic, parenthetical term, 'inherent,' the Office Action offers no basis, justification, or explanation of why or how an element of claim 11 may be considered inherently disclosed in prior art. In the complete absence of any support in the Office Action for the use of inherency, Applicants are under no obligation to comment further. In an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, however, Applicants nevertheless undertake to make their best guess regarding the meaning of the Office Action.

Applicants therefore assume that the Office Action intends to invoke the theory of inherency as a basis for anticipation of the "RFID identification tag code field" element of claim 11 in the present application. The Office Action apparently takes the position in effect that some disclosure in Reber necessarily results in the claim element recited above of a RFID inventory system with RFID identification tag code field. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherent" is insufficient basis for a rejection on the theory of inherency. In *Ex parte Levy*, the Board of Patent Appeals and Interferences states, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Manual of Patent Examination and Procedure* § 2112 (quoting *Ex parte Levy*, 17

USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action does not demonstrate in any way that anything in Reber necessarily results in a RFID inventory system with RFID identification tag code field. In fact, such inherency does not exist. A RFID inventory system with RFID identification tag code field cannot properly be said to necessarily flow from any of the teaching in Reber within the meaning of *Levy*. For this reason alone, Reber can be seen to not disclose or teach the claim element asserted on its behalf. Claim 11 therefore is patentable and should be allowed. Dependent claims 12-20 depend from independent claim 11. Because these dependent claims include each and every limitation of the independent claim from which they depend, these dependent claims stand because their independent claim stands. Claims 11-20 therefore are patentable and should be allowed.

Conclusion Regarding 35 U.S.C. § 102(e)

In rejecting claims 11-20 under 35 U.S.C. § 102(e) as being anticipated by Reber, the Office Action does not satisfy the legal requirements for rejections under 35 U.S.C. § 102(e). The Office Action fails to provide Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132 and therefore relieves Applicants of any duty to respond to the rejection. In a best effort to be fully responsive, however, Applicants explained above that the Office Action has not established anticipation by Reber because the Office Action does not even mention many of the elements of the Applicants' claims. Even examining Reber itself confirms that Reber does not anticipate each and every element of the Applicants' claims, expressly or inherently. Applicants therefore traverse the rejection to each of claims 11-20 in the present application. The rejections of all claims 11-20 under 35 U.S.C. § 102, therefore, should be withdrawn, and the claims should be allowed.

Rejections Of Claims For Obviousness Under 35 U.S.C. § 103 As Unpatentable Over Reber In View Of Well Known Prior Art Are Improper

Claims 11-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Reber in view of prior art that "would have been obvious to a person having ordinary skill in the art at the time the invention was made…." Applicants understand the Examiner's reference to 'ordinary skill' to be a reference to 'Well Known Prior Art.' Applicants respectfully submit in response that the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, Applicants note that the Office Action cannot rely on Well Known Prior Art to support the obviousness rejection. Applicants also note in response that the Office Action does not establish a prima facie case for obviousness. The proposed combination of Reber and Well Known Prior Art cited does not teach each and every element of the claims of the present application; there is no suggestion or motivation to combine Reber and Well Known Prior Art cited; and there is no reasonable expectation of success in the proposed modification. For all these reasons, the rejections should be withdrawn and the claims should be allowed.

The Office Action Fails To Provide The Applicants With Information Sufficient To Judge The Propriety Of Continuing Prosecution As Required By 35 U.S.C. § 132

As noted above, 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for rejections, including "such information and references as may be useful in judging of the propriety of continuing the prosecution…." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "…the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)…." MPEP § 707.07(d)

warns against omnibus rejections as, "…stereotyped and usually not informative and should therefore be avoided."

As mentioned above, the reference to Reber in the Office Action makes no mention of where in Reber the information relied on by the Examiner may be found. The only Well Known Prior Art reference cited by the Examiner with any specificity that would be useful in judging of the propriety of continuing the prosecution is Friedman, *et al.* (U.S. Patent 6,593,845) ('Friedman'). The Office Action under numbered paragraph 6 states:

> It is the Examiner's position that 'out-of-range' indicators in RF tag devices is old and well known in the art. Evidence to support this includes but is not limited to Friedman et. al. (U.S. 6,593,845 B1) column 5, lines 64-67.

Friedman at column 5, lines 64-67, however, states:

> Alternatively, the main tag circuitry 48 can provide the field-off signal if the RF field at the antenna 16 drops below the threshold for a certain period of time, such as indicating that the interrogator has moved out of range.

Friedman's RF tag having an 'out-of-range' indicator provides a signal when a device, referred to in Friedman as an 'interrogator,' travels out of range from the RF tag. The system of inventory control as claimed in the present application does not claim an RF tag having an 'out-of-range' indicator that provides a signal when an interrogator travels out of range from the RF tag. Friedman's RF tag having an 'out-of-range' indicator therefore is not a system for inventory control as claimed in the present application. The Office Action's reference to Friedman therefore does not establish that the Well Known Prior Art teaches or suggests Applicants' claims.

Because Friedman has nothing to do with Applicant's claims, the Office Action remains completely silent regarding the location of the information relied on by the Examiner to reject claims 11-20 other than generally citing Reber and the Well Known Prior Art. Both Reber and the Well Known Prior Art are complex references containing information

regarding many technical subjects and other inventions. In light of the requirements of 35 U.S.C. § 132, it is important for the Examiner to provide some indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber and the Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections. The rejection of claims 11-20 therefore should be withdrawn, and the claims should be allowed.

The Office Action Cannot Rely On Well Known Prior Art To Support The Obviousness Rejection

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

In rejecting claims 11-20 for obviousness under 35 U.S.C. § 103, the Office Action under numbered paragraph 6 states:

> …it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an RFID identification tag code field. Such a modification would have made it clear that RFID tags require unique ID numbers in order to properly identify the tag.

As stated above, the 'ordinary skill' so described is taken in this Response as 'Well Known Prior Art.' Applicants understand, based on this language from the Office Action, that this rejection, based on 'ordinary skill' so described, is a rejection relying on

common knowledge or Well Known Prior Art according to MPEP 2144.03. Applicants respectfully propose, however, that "to modify Reber to expressly indicate an RFID identification tag code field" is not available to the Examiner in this case as Well Known Prior Art.

According to MPEP § 2144.03, the Examiner may use as Well Known Prior Art facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in *In re Lee*, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). The court in *Lee* requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. *In re Lee*, 277 F.3d at 1345, 61 USPQ2D at 1435.

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no "objective evidence of record" and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated. The assertion in the Office Action that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an RFID identification tag code field" cannot be instantly and unquestionably demonstrated. For these reasons, the Office Action cannot rely on the assertion that such a modification is taught in the Well Known Prior Art to support the obviousness rejection. This rejection therefore fails to

establish a prima facie case of obviousness. Claims 11-20 are therefore patentable and should be allowed.

Reber and Well Known Prior Art Do Not Establish A Prima Facie Case For Obviousness

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

To establish a prima facie case of obviousness, three basic criteria must be met in accordance with MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

The Combination Of Reber and Well Known Prior Art Does Not Teach All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). In rejecting claims

11-20 under 35 U.S.C. § 103, the Office Action relies exclusively on Reber for disclosure or suggestion of several of the elements of claim 11. Office Action under numbered paragraph 4. As shown above, Reber does not disclose those elements relied on by the Office Action. The combination of Reber and Well Known Prior Art therefore cannot teach or suggest all of the Applicants' claim limitations. For these reasons, the proposed combination of Reber and Well Known Prior Art does not establish a prima facie case of obviousness. Dependent claims 12-20 depend from independent claim 11. These dependent claims include each and every limitation of the independent claim from which they depend. These dependent claims stand because independent claim 11 stands. The rejections of all claims 11-20 under 35 U.S.C. § 103, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 11-20 and request claims 11-20 be allowed.

No Suggestion or Motivation to Combine Reber and The Well Known Prior Art

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Reber. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Reber must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In this case, the Office Action makes no mention whatsoever of any evidence of suggestion or motivation to modify Reber, neither in Reber itself nor in Well Known Prior Art. Because the Office Action does not explicitly point a teaching within the cited

art that suggests or motivates the combination of Reber and Well Known Prior Art, the Office Action does not establish a prima facie case of obviousness. For this reason, the rejection of claims 11-20 should be withdrawn, and claims 11-20 should be allowed.

No Reasonable Expectation of Success in the Proposed Combination of Reber and Well Known Prior Art

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Reber. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). In this case, the Office Action makes no mention whatsoever of any evidence that a reasonable expectation of success in a proposed combination of Reber's disclosure of a food storage apparatus and a method of monitoring a food item with the "RFID identification tag code field" from Well Known Prior Art to produce claim 11 of the present application. As such, no proposed modification of Reber can establish a prima facie case of obviousness. For this reason, the rejection of claim 11 should be withdrawn, and claim 11 and all claims 12-20 depending from it should be allowed.

Conclusion Regarding 35 U.S.C. § 103(a)

In rejecting claims 11-20 as unpatentable over Reber in view of prior art that "would have been obvious to a person having ordinary skill in the art at the time the invention was made…," the Office Action does not satisfy the legal requirements for a rejection under 35 U.S.C. § 103(a). As explained above, the Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, the Office Action cannot rely on Well Known Prior Art to support the obviousness rejection. The Office Action also does not establish a prima facie case for obviousness because the proposed combination of Reber and Well Known Prior Art does not teach each and every element of the claims of the present application, there is no suggestion or motivation to combine Reber and Well Known Prior Art, and there is no reasonable expectation of success in the proposed modification. For all these reasons, the

rejections of claims 11-20 should be withdrawn and the claims should be allowed. Claims 1-10 and 21-30 claim method and computer program product aspects respectively of the systems claimed in claims 11-20, a relationship acknowledged in the Office Action at numbered paragraph 17. Because claims 11-20 stand, claims 1-10 and 21-30 also stand. Applicants therefore respectfully traverse each rejection individually of claims 1-30 in the present application because these claims are patentable and should be allowed.

Lexicography Of The Specification

The Office Action at page 4, states:

> Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings.

To support the Examiner's conclusion, the Office Action at page 4 states that "the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s)." That is, the Examiner implies that the Applicants have chosen not to define any terms in the specification because the Examiner cannot locate any lexicographic definition. Applicants note in response that the specification includes fifty pages that include eleven drawings and a section of definitions, beginning on page 8 of the original application and continuing through the top of page 10, expressly labelled as such with the underlined subtitle, "Definitions." Applicants note that, in addition to the section particularly devoted to definitions as such, various terms are expressly defined also throughout the specification. The following paragraph from page 10 of the original specification in this case, for example, sets forth definitions for "RFID," "RFID readers," and "RFID tags," all of which are terms that are used throughout the specification in accordance with these definitions:

> Turning now to Figure 1, a first embodiment of the invention is shown as a system for inventory control for inventory items having RFID tags. "RFID" means Radio Frequency Identification, a technology for identifying objects by use of an antenna, a transceiver, and a transponder.

> RFID transceivers, in this specification, are referred to as "RFID readers." As the term 'transceiver' implies, however, RFID readers both read and write information to and from RFID transponders. RFID transponders are referred to in this specification as "RFID tags." RFID tags are programmed with RFID identification codes unique to each RFID tag. In addition, RFID tags are programmed in some embodiments with other information in addition to RFID identification codes, such as, for example, inventory item type codes, location codes, inventory dates, control values, and so on.

Because Applicants have provided a section of definitions and various terms are defined throughout the specification, the implicit assertion in the Office Action that Applicants have chosen not to define any terms in the specification is incorrect. Applicants therefore respectfully submit that there is no support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

In further support of the Examiner's conclusion that the Applicants have decided not to be their own lexicographer, the Office Action at page 4 states:

> …the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements with the required clarity, deliberateness, and precision.

That is, the Office Action asserts that the Applicants' specification does not point to any of the claim terms and define those claim terms with the required clarity, deliberateness, and precision. This is simply and obviously untrue in view of the briefest and most casual glance at the present patent application. The present application is simply filled with definitions and explanations of claim terms, fifty pages including eleven drawings in which the claim, the claim elements, and all claim limitations are explained and defined in complete and absolutely perfect detail. Out of the dozens of terms so defined and explained, Applicants present for explanation two examples of such definitions and explanations, one for the claim term 'RFID' and one for the claim term 'OSGL.' The claim term 'RFID' appears in claim 1 as follows:

1. A method of inventory control comprising the steps of:

providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

an RFID identification tag code field,
a control value,
an acceptable control value range, and
an out of range action;

detecting changes in the inventory item attributes, wherein detecting changes in inventory item attributes includes reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item;

recording detected changes in inventory item attributes;

comparing the control value and the acceptable control value range; and

taking action in dependence upon the result of the comparing and the out of range action.

The claim term 'RFID' is defined and explained on page 10 of the original application as follows:

"RFID" means Radio Frequency Identification, a technology for identifying objects by use of an antenna, a transceiver, and a transponder. RFID transceivers, in this specification, are referred to as "RFID readers." As the term 'transceiver' implies, however, RFID readers both read and write information to and from RFID transponders. RFID transponders are referred to in this specification as "RFID tags." RFID tags are programmed with RFID identification codes unique to each RFID tag. In addition, RFID tags are programmed in some embodiments with other information in addition to RFID identification codes, such as, for example, inventory item type codes, location codes, inventory dates, control values, and so on.

The claim term 'OSGI' occurs in claim 2 as:

> 2. The method of claim 1 wherein the steps of detecting changes, recording detected changes, comparing the control value and the acceptable control value range, and taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway.

The claim term 'OSGI' is defined and explained on page 12 of the original application as:

> "OSGI" refers to the Open Services Gateway Initiative, an industry organization developing specifications for service gateways, including specifications for delivery of service bundles, software middleware providing compliant data communications and services through service gateways. The Open Services Gateway specification is a java based application layer framework that gives service providers, network operator device makers, and appliance manufacturer's vendor neutral application and device layer APIs and functions. An "API" is an Application Program Interface, a set of routines, protocols, and tools for building software applications.

The most casual glance at the present application immediately dispels any notion whatsoever that Applicants may have failed in any way to explain claim terms with reasonable clarity, deliberateness, or precision. Because Applicants' specification points to various claim terms and provides definitions for those claim terms with clarity, deliberateness, and precision, Applicants respectfully submit that there is no possible support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

Still further in support of the Examiner's conclusion that the Applicants have decided not to be their own lexicographer, the Office Action at page 4, states:

> …after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked, Applicants have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. § 1.111(b) (*i.e.* Applicants have not argued lexicography is invoked).

That is, the Office Action asserts that Applicants have decided not to be their own lexicographer because the Applicants did not point out supposed errors in the Examiners' position regarding lexicography in Applicants' Response to the Office Action dated February 3, 2005 ('First Office Action') in accordance with 37 C.F.R. § 1.111(b). Applicants' comments regarding lexicography in Applicants' Response to the First Office Action, however, does comport with 37 C.F.R. § 1.111(b). 37 C.F.R. § 1.111(b) states, "The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action…." The First Office Action at page 7 states that "the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning." In Applicants' Response to the First Office Action, however, Applicants provided an entire section entitled "Lexicography of the Specification" distinctly and specifically pointing out the error in the assertion of the First Office Action that the Applicants had no desire to be their own lexicographer. In the Response to the First Office Action, Applicants pointed out that the Applicants provided a specification of 50 pages that includes eleven drawings and *a section of definitions* to aid the Examiner in interpreting the claims. Applicants further noted that where an explicit definition is provided by the Applicants for a term, that definition will control interpretation of the term as it is used in the claim. By informing the Examiner that "a section of definitions" existed in the specification and that those definitions control interpretation of the claims, Applicants distinctly and specifically pointed out the supposed errors in the First Office Action in accordance with 37 C.F.R. § 1.111(b). Because the Applicants distinctly and specifically pointed out the supposed errors in the First Office Action, Applicants respectfully submit that there is no support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

In support of the Examiner's conclusion that the Applicants have decided not to be their own lexicographer, the Office Action at page 4, states:

> …the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer.

Applicants note in response that lexicography is the Applicants' right under 35 U.S.C. § 112, second paragraph, not a privilege granted to the Applicants through an Examiner's invitation. Manual of Patent Examining Procedure § 2173.01 states:

> A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification.

As noted above, Applicants' specification provides a section of definition that begins on page 8. In addition, Applicants clearly define various terms throughout the specification such as, for example, 'OSGI' on page 12 of the specification. Applicants therefore became their own lexicographer under 35 U.S.C. § 112, second paragraph, when the Applicants filed the present application on January 31, 2002. The Applicants therefore did not need to accept or reject the Examiner's invitation to be their own lexicographer. Because Applicants clearly set forth Applicants' intent regarding lexicography when the present application was filed, Applicants respectfully submit that there is no support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

Subject Matter Of Claims 11-30

The Office Action at page 5, states:

> The Examiner maintains his position that claims 11-30 are product or machine claims.

Applicants respectfully note in response that claims 11-20 are directed to a system patentable under 35 U.S.C. § 101. Independent claim 11 recites, "A system of inventory control…" dependent claims 12-20 depend from claim 11 and include all limitations of

claim 11 and are also directed toward a system of inventory control. Applicants also note with respect that the computer program products claimed in claims 21-30 are directed to patentable articles of manufacture within the meaning of 35 U.S.C. § 101. Independent claims 21 recites, "A computer program product of inventory control…" Dependent claims 22-20 depend form claims 21 and include all limitations of claim 21 and are also directed to an article of manufacture, a computer program product of inventory control.

Relations Among Claims

Independent claims 1 and 21 are method and computer program product claims for inventory control corresponding to independent system claim 11. As discussed above, Reber discloses a food storage apparatus and methods and systems for monitoring a food item. Reber, at the title block. In fact, Reber does not even mention inventory control. Therefore, for the same reason that Reber does not disclose or enable a system for inventory control, Reber also does not disclose or enable methods and computer program products for inventory control corresponding to independent claims 1 and 21. Independent claims 1 and 21 are therefore patentable and should be allowed.

Claims 2-10, 12-20, and 22-30 depend respectively from independent claims 1, 11, and 21. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Reber does not disclose or enable each and every element of the independent claims, Reber does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-10, 12-20, and 22-30 are also patentable and should be allowed.

Conclusion

Claims 11-20 stand rejected under 35 U.S.C. § 102 as being anticipated by Reber. Reber does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Reber therefore does not anticipate Applicants' claims. Claims 11-20

are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 11-20.

Claims 1-30 stand rejected under 35 U.S.C. § 103 as obvious over Reber in view of Well Known Prior Art. The combination of Reber and Well Known Prior Art does not teach or suggest each and every element of Applicants' claims. Claims 1-30 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-30.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: December 22, 2006 By:

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